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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/205,318	12/04/1998	ROBERT LEPAGE	97-060A	7911

7590 06/08/2005

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EXAMINER

JOHNSON, BLAIR M

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 06/08/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 23

Application Number: 09/205,318
Filing Date: December 04, 1998
Appellant(s): LEPAGE ET AL.

Paul B. Stephens
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the REMAND of 4/14/04.

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Note: The following changes have been incorporated into the Examiner's Answer of 9/23/03 to address the three concerns of the Board prompting the remand.

- (1) Discussion of inapplicability of Ex parte Eggert (item 12).
- (2) All conferees have initialed this paper.
- (3) A copy of the IDS of 12/4/98, acknowledged by the Examiner, is attached.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 20-27 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 20-27 are rejected under 35 U.S.C. 251. This rejection is set forth in prior Office Action, Paper No. 14.

(11) Response to Argument

The invention involves a roller door having tapered side edges which ride up and down in guides which diverge from top to bottom.

The critical limitations that are present in the patent claims (5,579,820) that Appellant is attempting to remove from the present claims are the tapering of the closure (roller door) and the guide means which diverge from top to bottom, both of which are related since the closure conforms to the guides. These limitations were present in the originally filed patent claims in some form but were further amended (narrowed) by patent owner on 5/30/96, the only amendment of the patented case.

In the remarks section of that amendment, patent owner proceeded to argue the merits of these two features, "tapering" and "diverging". In addressing the shortcomings of the prior art, patent owner continuously argues the importance of these features. In addressing Wellens (the only reference actually applied in the rejection), he states on page 6, lines 13-15, that "In the present invention, the section closing the trapezoidal

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opening is complementary in shape thereto and thus cannot be fairly compared to the Wellens system", the Wellens system which includes a screen which is "*vertically* guided along guide tracks", page 6, line 1, emphasis **not** added. He further states: "In fact, Claim 1 is considered to clearly distinguish from the Belgium Patent by claiming that the section of the flexible closure closing the shelter opening has side edges tapering towards the overhead roller provided at the narrow end of the shelter opening", page 6, lines 15-19. This is a clear indication that Applicant fully considered that the "diverging" feature rendered his claim allowable.

Regarding Applicant's remarks concerning both Ojima et al and German patent No. DE-38 41 139-A, he further stresses the level of importance of the "diverging" feature to overall patentability by stating that while these references do have diverging sides and guides, they differ in other structural ways, i.e. location of the roller. He states on page 7, lines 6-8, that these two references show the roller at the "large end of a trapezoidal opening as opposed to the device of the present invention which is, and must, be installed at the narrow end thereof", emphasis **not** added. Again, emphasis is put on the patentability of the "diverging" feature.

Regarding German, he again states that the closure is a "constant span", emphasis **not** added, and also addresses the "large" end verses the "narrow" end of the opening, as discussed above.

On page 8, Applicant summarizes his view of the patentability of claim 1 over the prior art as being attributable to the "tapering section", the

prior art having "rectangular" closures, etc. He states "Accordingly, Claim 1 has been herein amended in order to clearly distinguish from the citations and, more particularly, by reciting that the flexible closure includes a tapering section adapted to substantially completely close the door opening and to wind around an overhead roller provided at the upper, i.e. narrow, end of the door opening".

Consequently, it is clear from the specifics discussed above, as well as from the general view expressed by Applicant in the remarks of 5-30-96, that the diverging sides of the closure and the diverging guide means are the primary, and essentially only, feature which renders the claims allowable. Removing these features from the claims would be an attempt to recapture claimed subject matter.

Of critical importance is language added by way of Examiner's amendment of 6/10/96 by which was added "thereby diverging from top to bottom" in limiting the guide means. It is implicit that the Examiner considered this to be the patentable feature and, by accepting such language, such was agreed by patent owner.

Office policy is directed by the following decisions: Pannu V. Storz Instruments Inc., 258 F.3d 1366, 59 USPQ2d 1597 ; Ex parte Yamaguchi, 61 USPQ2d 1043.

Among the criteria for evaluating recapture, it must be determined whether the reissue claim entirely omits any limitation that was added/argued during the original prosecution to overcome an art rejection.

(Pannu). The "tapered" and "diverging" features, now omitted, were both amended and argued, as carefully detailed above. It is to be emphasized that these features have not been broadened, they have been omitted altogether. An Examiner's amendment, consented to by then Applicant, may be used to establish surrender claimed subject matter on which to base recapture (Yamaguchi).

MPEP 1412.02 is very clear that arguments alone can establish surrendered subject matter. Again, this applies to the present facts.

To repeat, patent owner both argued the omitted limitations as being critical to patentability and further amended the claims in this regard, through his amendment and the Examiner's amendment upon which he agreed.

Appellant's arguments suggests that since patent owner argued other limitations as lacking in the prior art, that this emphasis negates the importance of the omitted "tapering" and "diverging" features. This simply has not bearing on the determination of recapture as presented. He also argues that additional limitations are being added in the reissue claims. However, since such features are not related to those omitted, such an argument falls short. (Pannu).

On page 11 of the brief, Appellant states "That the question for reissue is not whether the excluded subject matter was necessary for patentability of the original claims.", and that "that could not be the case here, as the examiner has confirmed that the present claims excluding

these 'points of novelty' are indeed patentable". However, the present claims have added limitations that render them patentable, as evident from the record.

(12) Discussion of the Inapplicability of Ex parte Eggert

In the present instance, the original independent claim, which was rejected by the examiner based on prior art in the original application, did not contain:

Element X: "flexible closure means having a shape which tapers in a direction of said roller means"

Element Y: "wherein in said closed position, said section of said flexible closure means substantially completely closes the door opening"

To overcome the prior art rejection against the independent claim, the applicants amended the claim to add limitations X and Y. The applicant made the choice of inserting those claim limitations into the original independent claim (in the original application). The applicant chose not to prosecute further variations of the original independent claim. **At the present, on reissue, applicant is not permitted to completely delete these added limitations.** See *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), discussed below.

Eggert: The decision in *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003) (precedential opinion of an expanded panel of the Board) is **not applicable** to the facts of this appeal. The claims on appeal (claims 20-27 in the

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reissue application) omit in their entirety surrender-generating limitations, i.e., the limitation(s) added in the original prosecution to define over the art to secure allowance of the patent. This is because the limitations of **patent** claim 1 which are represented as elements X and Y above, in their entirety, are essentially absent from the **reissue** claims 20-27. Therefore, the claims impermissibly recapture what was previously surrendered, as explained in more detail below.

Patent claim 1 contains elements X and Y, which were indicated by applicant in the patented file (original application, paper no. 5, page 8) as clearly distinguishing from the citations. The remainder of the patent claims, i.e., claims 2-19, are dependent on claim 1, and thus also include elements X and Y.

The reissue claims:

1) Surrender-generating limitation X is completely omitted from the reissue claims 20 - 27, and therefore constitutes impermissible recapture of what was previously surrendered.

2) As to limitation Y, reissue claims 20 and 26, and their dependent claims 21-25 and 27, respectively, fail to recite element Y, but do recite that the roll-up closure device is adapted to be "movable between blocking and unblocking position." The new recitation in the reissue of the closure device being adapted to be movable between a blocking and unblocking position is not the inclusion of a broadened form of surrender-generating

limitation Y, since the originally filed claim, without the addition of surrender-generating limitation Y, recited that the closure means was displaced toward an open or a closed position. If the closure means is at the open position, it will not block; if the closure means is at the closed position, it will block. Thus, the newly added limitation in the reissue claims regarding the closure device being movable between blocking and unblocking position is inherent in the claims based on the originally claimed open and closed positions of the closure device; the blocking and unblocking limitations causing no narrowing of the scope of the originally filed claim. As such, the blocking and unblocking limitation in the reissue claims cannot be considered a broadened form of the surrender-generating limitation Y, but is rather a restated form of original claim 1 as it appeared prior to the insertion of limitation Y.

3) The new limitations added via reissue claims 20-25 regarding "guide engagement members" and the "elastic member coupled to the curtain," and the new limitation added via reissue claims 26-27 regarding "laterally inwardly biasing means" are narrowing limitations (as compared with the patent claims). These new narrowing features, however, are not related to elements X and Y (whose omission in the reissue claims 20 - 27 results in surrender).

Accordingly, reissue claims 20-27 are broader than the original patent claims 1-19 by not including the surrender-generating limitations, elements X and Y, of patent claims 1-19. This broadening of the claims is barred by the recapture rule, even though there is narrowing of the claims (e.g., "guide engagement members", "elastic member coupled

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to the curtain", "laterally inwardly biasing means") **not related to the surrender-**
generating limitations.

In view of *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), if a reissue claim is broader in an aspect germane to what was surrendered in response to a prior art rejection, but narrower in another aspect completely unrelated to what was surrendered, the recapture rule bars the claim. This is the understanding of how the shorthand set forth in *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165 for the broadening/narrowing scenario 3(a), is applied in light of *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) and *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001) both of which pointed out that one should look at the limitation **relied upon to define the invention over the prior art**, and determine if that limitation is omitted in the reissue claims. Note also the statement in *Clement* that every time the claims are narrowed by amendment, subject matter is surrendered. *Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166 ("[E]very time Clement amended his claims, he intentionally omitted or abandoned the claimed subject matter.").¹

The limitations of elements X and Y in claims 1-19 of the original patent are germane to what was surrendered in response to a prior art rejection, as these limitations were

¹ This statement that every time the claims are narrowed by amendment, subject matter is surrendered, calls for analyzing reissue claims for whether a key narrowing that was made in the original prosecution has abandoned, i.e., surrendered, subject matter that the patent owner is now seeking to recapture by reissue. Thus, the insertion of a narrowing unrelated to the abandoned (surrendered) claim subject matter that owner is impermissibly trying to recover does not save the claim from the recapture doctrine.

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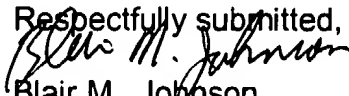
added by amendment after a prior art rejection of the originally filed and sole claim 1 and were indicated by applicant (original application, paper no. 5, page 8) as clearly distinguishing the claims (i.e., claim 1 and newly added dependent claims 2-19) over the prior art. Therefore, the limitations of elements X and Y were necessary in order to secure a patent. Similar to the facts in *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), the applicant has broadened the reissue claims in an aspect germane to what was surrendered in response to the prior art rejection, and has narrowed in an area not related to the surrender. The decision in *Pannu* is on point as to the issues on appeal, because it provides an actual fact situation in which this scenario was held to be recapture.

Because reissue claims 20 through 27 omit the surrender-generating limitations, elements X and Y, and fail to include a replacement limitation in the area of the surrender, *Pannu* is on point while *Eggert* is not, and claims 20 through 27 impermissibly recapture what was previously surrendered.

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In view of the facts of the case and the remarks presented above in support thereof, it is believed that the Examiner should be affirmed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Blair M. Johnson
Primary Examiner
Art Unit 3634

BMJ
May 24, 2005

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